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20 **UNITED STATES DISTRICT COURT**
21 **NORTHERN DISTRICT OF CALIFORNIA**

22 **SAN FRANCISCO DIVISION**

23 ORACLE AMERICA, INC.

Case No. CV 10-03561 WHA

24 Plaintiff,

**ORACLE AMERICA, INC.'S MOTION
SEEKING A CLARIFYING INSTRUCTION
AND PROFFER REGARDING APACHE
HARMONY**

25 v.

26 GOOGLE, INC.

27 Defendant.

Dept.: Courtroom 8, 19th Floor
Judge: Honorable William H. Alsup

1 Oracle requests that the Court give a clarifying instruction to the jury regarding Apache
 2 Harmony to minimize jury confusion on the legal significance of Apache Harmony.

3 **Introduction**

4 Google has repeatedly argued to the jury that Apache Harmony had used Sun's Java APIs and
 5 that "Sun said fine." (E.g., 4/17/2012 Trial Tr. at 251:14-252:3 (Google Opening Statement).)
 6 Google has also repeatedly argued, and elicited evidence, that it took the 37 accused APIs from
 7 Harmony. Further, Google repeatedly refers to its distribution of Android under an "Apache
 8 license," which does not actually mean any license from Sun to Apache or Apache to Google, but
 9 instead confusingly refers to the standard Apache terms that Google imposes on Android licensees.
 10 These arguments create a substantial risk of juror confusion and prejudice to Oracle.

11 Two of the three questions from the jurors have focused on Apache, but the issue is actually
 12 very simple: Apache never obtained any license from Sun permitting its use of the Java
 13 specifications for Harmony. As made clear by Apache itself, Apache never had a license from Sun or
 14 Oracle for Harmony. Apache had no rights to Java technology that it could give to Google. This not
 15 even a case in which there is a "cloud over Apache," to use the Court's phrase (4/20/2012 Trial Tr.
 16 1114:16-20). Apache simply had no title at all, and has publicly conceded as much: When Apache
 17 resigned from the JCP in protest based on its inability to obtain a license, it stated in its resignation
 18 that the "Java specifications are proprietary technology that must be licensed directly from the spec
 19 lead under whatever terms the spec lead chooses." (TX 1045 at p. 2.)

20 Thus, Google's use of Apache Harmony provides no defense for Google. Oracle seeks an
 21 instruction to the jury that will prevent confusion and clarify that Google's use of Harmony provides
 22 no defense to Oracle's copyright infringement claims.

23 **Background**

24 Before 2007, the Apache Software Foundation ("Apache") began a project to develop an
 25 independent Java SE implementation, which it named Harmony. Apache used the specifications set
 26 forth on Sun's website to implement the Java APIs in Harmony. (4/17/2012 Trial Tr. at 251:15-16
 27 (Google opening).) Use of those specifications for an independent implementation requires a
 28 specification license, and if any distribution of the independent implementation is sought, a TCK is

1 license is required. (TX 610.2) Apache sought a TCK license from Sun for Harmony, which Sun
 2 refused to grant without a field of use restriction that would prohibit any use in mobile devices. In
 3 April 2007, Apache posted on its website a letter to Sun's Jonathan Schwartz in which Apache
 4 criticized Sun for refusing to grant Apache a TCK license for Harmony. (TX 917.) Apache stated
 5 that Sun was offering a TCK license for Harmony, but Sun's insistence that its licenses include "field
 6 of use"¹ restrictions, prevented Apache from accepting the license. (*Id.*)

7 The disagreement and negotiations between Sun and Apache continued for a number of years,
 8 and in the end Apache never received any license from Sun for Harmony. (4/17/2012 Trial Tr. at
 9 396:8-9 (Kurian); 4/18/2012 Trial Tr. at 527:18-20 (Screven); 4/19/2012 Trial Tr. at 829:6-10 (Lee).)
 10 Apache resigned from the JCP in protest based on its inability to obtain that license, and stated in its
 11 resignation that the "Java specifications are proprietary technology that must be licensed directly
 12 from the spec lead under whatever terms the spec lead chooses." (TX 1045 at p. 2.) Apache then
 13 later retired the Harmony project. (4/18/2012 Trial Tr. at 530:2-5 (Screven testimony).²)

14 Oracle's Concern

15 Google's presentation of evidence related to Apache Harmony will confuse and mislead the
 16 jury and prejudice Oracle. Consistent with settled copyright law, the parties have agreed that Google
 17 "cannot excuse what would otherwise be copyright infringement by claiming that it copied, with or
 18 without a license, from a third party, who in turn had copied from Oracle. (Dkt. 539 at 61 (Google's
 19 Proposed Jury Instruction No. 18); *compare id.* at 60 (Oracle Proposed Jury Instruction No. 18).)
 20 Google's repeated invocation of Apache Harmony and the "Apache license" risks leading the jury
 21 into legal error and confusion. Accordingly, clarification from the Court is both necessary and
 22 proper.

23 In its opening, Google featured a May 2007 internet publication that quoted Sun's Jonathan
 24 Schwartz as stating "there is no reason that Apache cannot ship Harmony today." (TX 2341.) When

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 26 ¹ Field of use restrictions prevented Harmony from being used on devices other than computers, such
 27 as mobile phones. (4/18/2012 Tr. at 524:19-25 (Screven)).

27 ² See <http://harmony.apache.org/subcomponents/drlvm/> ("Apache Harmony is retired at the Apache
 28 Software Foundation").

1 questioned by the Court about that article, Google's counsel characterized the article as "an excerpt
 2 from a press release where Mr. Schwartz said you can ship as long as you don't call it Java."
 3 (4/20/2012 Tr. at 1123:17-1124:5.) That characterization of the exhibit was inaccurate. The exhibit
 4 is not a press release. In the article, there is no mention by Mr. Schwartz or anyone else whether
 5 Apache or anyone else would "call it Java." Indeed, the article repeats much of the licensing dispute
 6 between Sun and Apache recounted above. Immediately following the quote cited by Google, the
 7 article states, "That is technically true but Apache officials said that to do so with the TCK
 8 restrictions in place would actually go against the Apache Software license." (TX 2341.)

9 Oracle is also concerned that Google is conflating and confusing three separate issues
 10 regarding "Apache" in general: (1) Apache's use of Sun's Java specifications for Harmony; (2)
 11 Google's use of code from Apache Harmony; and (3) Google distribution of Android under the
 12 Apache license. In its 10-minute presentation to the jury, Google's counsel stated that:

13 Third piece of importance evidence, you know now Apache was out there using these
 14 APIs, the same Structure, Selection and Organization they are claiming now, and they
 have been out there for years.

15 Apache was out there selling -- now, there's an Apache license that Apache gives.
 16 When Mr. Rubin is here next week, you'll hear that Google is distributing Android
 17 under the Apache license, which allows you to use all the APIs, some of the APIs,
 none of the APIs. The Apache license is what Google has been distributing under.

18 But the key point of Apache is not its license. The key point is, Sun was fully aware
 19 that here is somebody out there making these libraries and APIs available and they
 didn't do anything about it.

20 (4/20/2012 Tr. at 940:16-941:9.) There is no dispute that Google offers Android under an Apache-
 21 style license, and that Apache used the Java specifications for Harmony, and that Google used
 22 Harmony code for Android. But those are separate issues, and Google's presentation risks
 23 confusion.³ Indeed, the form of license under which Apache distributed Harmony and under which
 24 Google distributes Android is irrelevant to any issue in this case. Google's repeated reference to

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 26 ³ Indeed, the Court previously noted the risk of juror confusion when two different pieces of evidence
 27 coincidentally are described the same way. (Mar. 7, 2012 Hearing Tr. at 56:16-57:6 (warning that
 jurors would be confused by the fact that Java engineers grouped the patents in the Sun Java mobile
 technology portfolio into 22 categories, and then identified the top 22 patents overall)).

1 these irrelevant licenses could foster the misperception that Apache—and by extension Google—had
2 a license from Sun.

3 Apache acknowledged publicly – and Google has not disputed – that Apache had not obtained
4 any license from Sun for Harmony, and warned that users of Harmony would not have all necessary
5 IP rights from Sun. In connection with the letter that Apache posted to its website in April 2007 (TX
6 917), Apache also posted a FAQ (TX 1047), which stated in pertinent part that if Apache chose to
7 distribute Harmony, “users wouldn’t be assured that they had all necessary IP rights from the spec’s
8 contributors.” (TX 1047).

9 The webpage containing Apache’s April 10, 2007 letter to Sun recognized that Apache
10 needed a TCK “to demonstrate compatibility with the Java SE 5 specification, as required by the Sun
11 specification license for Java SE 5.” (TX 917.) Sun’s specification license permitted development
12 and distribution of an “Independent Implementation of the Specification” but required that any such
13 implementation pass the TCK and stated: “The foregoing license is expressly conditioned on your
14 not acting outside its scope. No license is granted hereunder for any other purpose.” (TX 610.1).
15 Apache never passed the TCK for Harmony, and Apache had no license.

16 The statement attributed to Mr. Schwartz in Trial Exhibit 2341 is consistent with Apache’s
17 own statements, which confirm that Apache could comply with Sun’s TCK terms and ship, but until
18 then, Apache had not obtained the necessary IP rights from Sun and any users – such as Google –
19 would be at risk. As recently as December 2010, when Apache resigned from the JCP Executive
20 Committee, Apache recognized that the “Java specifications are proprietary technology that must be
21 licensed directly from the spec lead under whatever terms the spec lead chooses.” (TX 1045 at p. 2.)

22 **Oracle’s Request For Relief**

23 To address the potential confusion and prejudice caused by Google’s arguments regarding
24 Apache Harmony, and also possibly to streamline the next phase of this trial and prevent the
25 introduction of unnecessary and confusing evidence, Oracle believes that a clarifying instruction to
26 the jury regarding the Apache Harmony issues is warranted. Oracle proposes the following:

27 You have heard testimony regarding a project called Apache Harmony, and you have
28 also heard testimony regarding an Apache license. These are two separate issues, and
I will provide some clarification on those two issues now.

Harmony was a project by the Apache Software Foundation to develop an independent implementation of Sun's Java specification. The parties do not dispute that the Apache Software Foundation used Sun's Java specifications for Harmony. There is also no dispute that the Apache Software Foundation sought a TCK license from Sun for Harmony, but Sun refused to grant one.

There has been evidence that Google used code from Harmony for Android. Because Sun never granted the Apache Software Foundation a TCK license for Harmony, you may not find that Google's use of Harmony conveyed to Google any rights to use Sun's Java specifications, or provides Google with any defense to copyright infringement, if you find that such infringement occurred.

You have also heard about the “Apache license.” The Apache license is a type of open source license that Google chose for its distribution of Android. It is not a license under which Sun made Java intellectual property rights available. Google’s distribution of Android under an Apache-type license is separate from the issue of Apache Harmony. The fact that Google distributes Android under an Apache license has nothing to do with Google’s use of code from Harmony, and also does not provide Google with any defense to copyright infringement, if you find that such infringement occurred.

Dated: April 22, 2012

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